

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Walter Fix et al.
Serial No.: 10/562,869 Filed: April 7, 2006
For: Logic Gate with a Potential-Free Gate Electrode for Organic Integrated Circuits
Examiner: Eva Y. Montalvo Art Unit: 2814
Attorney Dkt: 411000-144 Customer No. 27162

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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This paper is a request for a pre-appeal review of the file and involved issues. None of the filed papers have been assigned paper numbers to the extent the undersigned is able to ascertain. The papers are identified by mail or file date. A non-final Action issued on 12/28/09 (originally final and withdrawn). On April 27, 2010, a response to the Action was filed wherein claim 1 was amended as follows:

the drain-source electrodes of the charging and switching transistors being arranged to be coupled in series between a voltage source and a reference potential such that the gate electrode of the charging FET is not connected via an electrical line directly to a voltage source, to the reference potential, to the input or to the output; wherein the gate electrode of the charging FET is directly capacitively coupled to one of the source/drain electrodes of the charging FET to thereby provide a potential at the gate electrode of the charging FET solely via the capacitive coupling (underlining is amended material)

On 7/16/10, a final Action issued wherein the specification is objected to as failing to provide antecedent basis for the underlined claim portion. Claim 1 is rejected under 35 USC 112, 1st paragraph, wherein the underlined portion of claim 1 is stated to not be disclosed in the specification or drawings. On Oct. 15, 2010, applicants filed an amendment, page 2, amending the specification and the drawing by attaching new figures 5 and 6. The amended spec describes the new drawings. Applicants presented

arguments showing why there is support in the as filed specification for the amendments made at page 3, last paragraph to page 7, second paragraph, of the filed response wherein the specification is quoted as describing two embodiments, one with just a capacitor being coupled between one of the transistor's source/drain electrodes and the other wherein a resistor is coupled in parallel to the capacitor.

Not pointed out in that filed response, the specification also states a page 3, lines 25-28,

"In the case of a capacitive coupling between the gate electrode and source or drain electrode of a charging FET, it is possible to dispense with a direct electrical coupling between the two electrodes."

This means to one of ordinary skill that no ohmic coupling (resistive) is made between the gate electrode and the one source or drain electrode. A capacitive coupling inherently means to one of ordinary skill a dielectric (insulating material) coupled between two conductive terminals and thus there is no direct electrical coupling made by a capacitor. The drawings figures 2 and 3 both show a capacitive and resistive parallel coupling between the gate electrode and either the source electrode (S) or the drain (D) electrode and no other elements coupled to the gate electrode.

No figures are provided in applicants' specification showing the embodiment wherein "it is possible to dispense with a direct electrical coupling between the two electrodes." One of ordinary skill would understand that this statement means it is possible to eliminate the resistive (R) coupling of resistor 18 in Figs. 2 and 3, which otherwise would provide "a direct electrical coupling between the two electrodes." Also, it is plain that one of ordinary skill would understand that by eliminating the R coupling (a direct electrical coupling between the two electrodes) all that would be left in Figs. 2

and 3 would be solely a capacitive coupling between the gate and S or D electrodes. One of ordinary skill is not without common sense.

There are two disclosed embodiments in the filed specification, which are described in detail in applicants' Oct. 15, 2010 filed response as noted.

After several weeks passed since filing the response, in early November, the undersigned called the examiner to determine the status of that response and was told the amendment is not being entered as new matter. The undersigned requested and was granted an interview, which was held on Nov. 17 between the undersigned, the examiner Ms. Montalvo and her supervisor Mr. Fahmy. To date, no interview summary was provided applicants. The supervisor was the PTO primary speaker in the interview.

Since the proposed amended claim 1 was not being entered, a further amended claim 1 was faxed to Ms. Montalvo on Nov. 12, incorporating the language "with no direct electrical coupling between the two electrodes" in place of the objected to term. This was prior to the interview of Nov. 17 and prior to when the undersigned first learned of the real reason for the new matter rejection. It was indicated this claim has new issues and an RCE would have to be filed to enter that claim.

Meanwhile, on Nov. 12, the undersigned received an Advisory Action, which states the originally filed specification discloses that the gate is capacitively coupled, it does not teach the claimed limitation in that the teaching "does not exclude the gate electrode from being coupled to other elements." This argument was not discussed in the Nov 17 interview and is not relevant to the new matter issue. This argument is directed to claim construction as viewed against a cited reference and not to whether or

not the specification supports what is being claimed. This argument was not raised during the interview of Nov. 17.

Instead the incredulous argument was first made during the interview that a capacitor has inherent parasitic resistances and thus applicants do not disclose "solely a capacitor" since such a disclosed capacitor by applicants specification must also have a parasitic resistance. The undersigned was told that the examiner had checked this issue with others in the PTO who provided this explanation, but did not name the person(s). Thus, it was asserted, for the first time, such a capacitance, without a parasitic resistance, was not disclosed and thus, the claim and proposed amendment to the specification are new matter. This reasoning is hypertechnical and has no support as a technical basis for rejecting the amended claim subject matter as new matter.

If all capacitors have a parasitic resistance then the supervisor was asserting that no applicant could ever claim "solely a capacitor" unless the applicant also disclosed no such parasitic resistance. The examiner has not provided any evidence that there is such a capacitor with or without such a parasitic resistance assuming the examiner is correct about this technology of which the undersigned has no knowledge. *The McGraw Hill Dictionary of Scientific and Technical Terms*, 1974, page 218, defines a capacitor:

"consists essentially of two conductors insulated from each other by a dielectric and which . . . stores electrical energy, blocks the flow of direct current"

This dictionary nowhere defines a capacitor as having a parasitic resistance as asserted and wherein no affidavit or other evidence was provided applicants during the interview as to this subject matter. More importantly, there was no evidence provided that there is a direct electrical coupling provided by a capacitor as claimed. The claim is directed

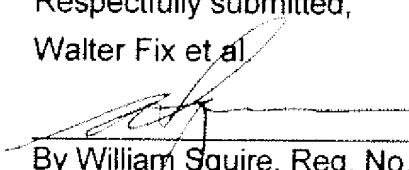
to solely a capacitor. What is internal the capacitor is irrelevant. It still is only a capacitor. One can go to any electrical supply store and order a capacitor and would receive a component comprising a body containing the dielectric and two connecting leads. That is what a capacitor is and that is what is being claimed.

The specification as amended and the added drawings merely reflect what is already disclosed in the filed specification, but is added to provide further antecedent basis support for the amended claim as required by PTO procedure that all claims must be shown in a drawing if the claim admits of such a drawing.

The supervisor also raised the issue that the term "solely" is not used in the specification. The undersigned stated that the exact terms in a claim do not have to appear in the specification. There is no requirement of identity of terms in a claim and the specification. It is not new matter to so add a claim. The undersigned cited *In re Wright*, (9 USPQ2d 1649 (Fed. Cir. 1989)). The supervisor then dropped this issue. For these reasons the amended claim and specification are not new matter and the amendment should be entered and the claims allowed.

Respectfully submitted,

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